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08/1815 773

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/1815, 773	03/12/97	BAUMGARTNER	J 95-33
		EXAMINER	
		HM11/1208	
GARY E PARKER ZYMOGENETICS INC 1201 EASTLAKE AVENUE EAST SEATTLE WA 98102		LAZAR WEELEY E ART UNIT	PAPER NUMBER
		1646	11
		DATE MAILED:	12/08/98

This is a communication from the examiner in charge of your application.  
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### OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on July 14, 1998
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 33-38 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 33-38 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been:
- received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The declaration filed on August 26, 1998 under 37 CFR 1.131 has been considered but is ineffective to overcome the Collins reference.

The declaration is ineffective, because it is not signed by one of the inventors, Theresa Farrah. The examiner takes note that Theresa Farrah was not available for signing at the time the declaration was filed, but should be available by the end of September.

Applicant is encouraged to obtain the missing signature. Other measures will be considered in case this is not possible.

The rejection of claims 33-38 under 35 USC 102(e), made in the office action mailed 2/24/98, is maintained.

### ***Claim Rejections - 35 USC § 112***

2. Claims 33-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are to a method using a polypeptide comprising a segment selected from the group consisting of:

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a) residues 141-337 of SEQ ID No:2; and

b) an allelic variant of (a)

The written description sets forth SEQ ID No:1 that reveals an open reading frame encoding SEQ ID No:2 having 380 amino acids (page 10, lines 4-9). The specification discloses a DNA and protein sequence from an additional human clone (SEQ ID No:3 and 4, page 12, lines 14-16). However, the written description is not commensurate in scope with the claims drawn to an allelic variant of a DNA encoding the polypeptide comprising residues 141-337 of SEQ ID No:2.

Rieger et al., *Glossary of Genetics and Cytogenetics, Classical and Molecular*, 4th Ed., Springer-Verlag, Berlin, 1976) clearly defines alleles as one or two or more alternative forms of a gene occupying the same locus on a particular chromosome.... and differing from other alleles of that locus at one or more mutational sites (page 17). Thus, the structure of naturally occurring allelic sequences are not defined. With the exception of the sequences disclosed, the skilled artisan cannot envision the detailed structure of the encompassed allelic variant and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is a part of the invention and a reference to a potential method of isolating it. The structure itself is required.

3. No claim is allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eliane Lazar-Wesley, PhD, whose telephone number is (703) 305 4059. The examiner can normally be reached on Monday-Friday from 8:30am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

Official papers filed by fax should be directed to (703) 308 4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*ELW*

ELW

December 3, 1998



LILA FEISEE  
SUPERVISORY PATENT EXAMINER